

Appl. No. 09/328,667

Attorney Docket No.: 113394

REMARKS

Claims 1-5, 7-15, 17-25 and 27-30 remain pending in this application. These claims stand rejected under 35 USC 103(a) as unpatentable over Galasso or Galasso in view of Sengodan.

The Issue at Hand

The point of disagreement at this point between applicant and the examiner is the meaning of the following sentence appearing at col. 7, lines 41-43 of the Galasso patent making reference to the gatekeepers shown in FIG. 3 of the Galasso patent:

If desired, the US master gatekeeper 550 can directly query the Europe master gatekeeper 560 for address translation when required

Applicant's position is that—taking the disclosure of the Galasso patent as a whole, and reading the above-quoted sentence in context—the term “directly query” means that the US master gatekeeper 550 would focus its query on Europe master gatekeeper 560 in the first instance by specifying Europe master gatekeeper 560 as the entity from whom the information is sought. However, the request focused on Europe master gatekeeper 560 would still pass through global master gatekeeper 570 because the route for queries from US master gatekeeper 550 to Europe master gatekeeper 560 was intended to include global master gatekeeper 570. Global master gatekeeper 570 would, in that case, simply be acting as part of the H.323 signaling infrastructure as a way for US master gatekeeper 550 to get its request delivered to Europe master gatekeeper 560.

By contrast, the examiner cites a Webster's dictionary definition of the word “directly” in support of his position that Galasso's use of the term “directly query” means that there would be a direct physical connection between the US and Europe master gatekeepers. The examiner also states that applicant's interpretation of what is meant in Galasso by “directly query” does not reflect the Webster's dictionary definition meaning of the term. (It is further the examiner's position that if Galasso is interpreted in that way, applicant's claims would be rendered unpatentable.)

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Summary of this Response

In response to the Office action,

a) Applicant respectfully submits that a dictionary definition is not a proper source of interpreting the meaning of a term in prior art reference, and.

b) Applicant respectfully submits that even if a dictionary were to be a proper source of interpreting the meaning of a term in a prior art reference, the dictionary definition of the term “directly” cited by the examiner is not inconsistent with applicant’s interpretation of the word “directly.”

c) Applicant hereby submits with this Response a declaration under 37 C.F.R. 132 from Michael B. Jones. Mr. Jones is one of the inventors of the Galasso patent. His declaration supports applicant’s position in all material respects.

Detailed Response

Use of Dictionary Definitions

It is respectfully submitted that when construing an applicant’s claim, it may well be appropriate to consult a dictionary. In the situation of examining a claim for possible overbreadth, the examiner is duty-bound to give the terminology in a claim its broadest reasonable reading when determining whether that claim reads on prior art. Thus any reasonable definition of a claim term—if found in a dictionary—can be used.

The interpretation task is different, however, when the question is the meaning to be accorded to a teaching in a prior art reference—in this case the Galasso patent. The issue here is not about the breadth to be accorded to language in applicant’s claims. The issue here is what would the term “directly query” would actually mean to a person skilled in the art reading the Galasso patent? What actual technical teaching, knowledge or information would the person skilled in the art glean from the patent?

It is submitted that, first and foremost, a technical person does not consult a dictionary to understand or interpret a technical document. Not when an understanding

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can be gotten from the document itself. And certainly a dictionary definition would not be relied upon by a technical person reading a technical document to infuse meaning and understanding into that document when the dictionary definition is at odds with a clear understanding that can be gleaned from the document itself.

Dictionary Definition Not Inconsistent with Applicant's Interpretation of the Term "Directly Query"

In any event, contrary to what is stated in the Office action, applicant's interpretation of "directly query" does reflect the meaning of the word "directly." The Office action states the definition of "directly" as being "proceeding from one point to another in space or time without any interruption or anything intervening." (Office action, p. 5, lines 4-10.) Indeed, applicant notes that a direct query is a query that passes between the endpoint parties without any intervening entity being queried, consistent with the quoted definition. Thus, contrary to what is suggested in the Office action, the meaning of the term "directly query" in the way that applicant here urges does reflect the meaning of what "directly" is defined as.

The reasoning set forth in the Office action proceeds as though the Galasso patent was saying that the US master gatekeeper is directly connected to the Europe master gatekeeper. But Galasso does not say that the US master gatekeeper is directed connected to the Europe master gatekeeper. If Galasso said that, the point urged in the Office action might be more supportable.

Instead what Galasso says is that the US master gatekeeper can directly query the Europe master gatekeeper. The word "directly" does not stand by itself; it modifies the word "query." As noted above, making a direct query to the Europe master gatekeeper is not inconsistent with that query passing through the global master gatekeeper. The global master gatekeeper in that case would not be serving to answer queries, but as a switching point for sending the query on to the entity that is actually being directly queried—the Europe master gatekeeper.

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Declaration of Michael B. Jones, an Inventor on the Galasso Patent,
Affirms Applicant's Position

Consistent with the foregoing, and supporting applicant's position, is the accompanying declaration under 37 C.F.R. 1.132 from Michael B. Jones. Mr. Jones is one of the inventors of the Galasso patent and is thus a credible, independent source of information as to a) what the inventors on the Galasso patent intended by "directly query" and b) what a person skilled in the art reading the Galasso patent would understand the term "directly query" to be referring to.

Among some of the points made by Mr. Jones, and supported by facts and reasoning, are the following:

- A direct query as envisioned by the Galasso patent inventors was one in which the US master gatekeeper 550 would specify the Europe master gatekeeper 560 as the entity from whom the information is sought but the request would pass through global master gatekeeper, acting as part of the H.323 signaling infrastructure. [Paragraphs 10 and 11.]
- The "directly query" scenario is disclosed in the Galasso patent as an alternative to a different embodiment disclosed in Galasso in which the global master gatekeeper is queried, which would then be an indirect query of the Europe master gatekeeper. [Paragraph 9.]
- A person skilled in the art, upon considering the Galasso disclosure as a whole, would interpret the term "directly query" as still involving the global master gatekeeper. [Paragraphs 17 and 18].
- Particular passages in the Galasso patent would lead the person skilled in the art to understand that all of the disclosed scenarios would involve communications up and down through a hierarchy, i.e., through global master gatekeeper 570. Mr. Jones cites two particular passages in the Galasso patent, both of which make clear that all communications within networks of the type disclosed in the patent would involve hierarchical signaling rather than direct signaling between entities at the same hierarchical level. [Paragraph 19]

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- Use of the term “directly query” is not inconsistent with the query being passed through the global master gatekeeper because to directly query the Europe master gatekeeper means only that the Europe master gatekeeper is the entity being queried without the query being directed first to an intermediary, such as global master gatekeeper. Use of the term “directly query” does not preclude the possibility that the query will pass through the global master gatekeeper without the global master gatekeeper actually being asked for an answer. [Paragraph 13.]
- The word “directly” as used in Galasso does not imply a physical connection between the US and Europe master gatekeepers that does not include global master gatekeeper 570. Mr. Jones believes that the examiner has confused the idea of a direct query, wherein only the Europe master gatekeeper is being asked for a reply, with the idea of a direct physical connection, which is something totally different. [Paragraphs 14 and 15.]
- Referring to a dictionary definition is not the way that a trained engineer or other technologist reads or interprets technical material. Rather, the way in which such a person would come to an understanding of a term in a technical passage, such as the term “directly query” in the Galasso patent, would be to try to derive the intended meaning from the context—that is, from the technical material itself. The fact that a dictionary may include a different meaning would not override, in the mind of a technical reader, the clear technical import of a disclosure in which the word is used to mean something else. [Paragraph 16.]

Patentability of Applicant's Claims

In view of the foregoing, it is submitted that a person skilled in the art, reading Galasso, would not understand the term “directly query” to mean a direct physical connection between the US and Europe master gatekeepers. Therefore, as argued by applicant in prior filings (e.g., Applicant's Amendment of 06/02/2004), the language in applicant's claims stating that the recited request was received from the third gatekeeper

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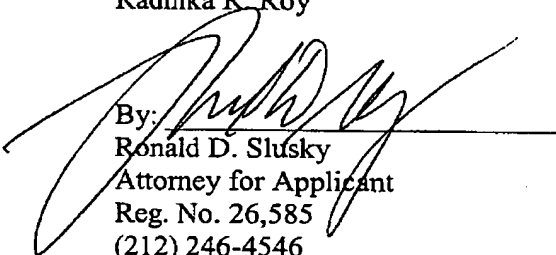
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"without said request having been sent through any other gatekeeper" is not anticipated by any teaching in Galasso. All requests from Galasso's US master gatekeeper to the Europe master gatekeeper—whether in the form of a direct query or otherwise—would pass through the global master gatekeeper. This is contrary to applicant's claim language.

In view of all of the foregoing, it is respectfully submitted that each of applicant's claims distinguishes the invention from the prior art.

Reconsideration is requested.

Respectfully,
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